

## REMARKS

In the Official Action mailed on February 9, 2005, the Examiner again rejected all pending claims 1-44. As discussed in detail below, Applicants firmly believe that the present claims are distinguishable over the prior art and in condition for allowance. Furthermore, Applicants note that the present application has been pending since March 1, 1999, so the prosecution has already been unduly prolonged. After reviewing the present rejections, Applicants respectfully submit that the Examiner has misapplied long-standing legal tenets and adopted untenable interpretations of both the prior art and the pending claims in formulating the present rejections and that the Examiner has, thus, overlooked the importance of the Examiner's role in allowing claims that properly define the invention and distinguish over the prior art. *See* M.P.E.P. § 706. Accordingly, should the Examiner choose to maintain any of the present rejections after considering the remarks set forth below, Applicants respectfully request an interview with the Examiner's supervisory Examiner prior to issuance of the next official action.

In addition, prior to addressing the specific rejections, Applicants note that the outstanding official action *did not set a shortened statutory period for reply*. Accordingly, the present response should be deemed timely if filed on or before August 9, 2005, with no extension fees being due.

### **Rejection Under 35 U.S.C. § 112**

The Examiner has once again maintained the rejection of claims 6, 12, 19, and 44 under the 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one of ordinary skill in the art to make and/or use the invention. Once again, Applicants respectfully traverse this rejection. Applicants

have already addressed this rejection twice, yet the Examiner continues to ignore numerous binding rules and long-standing precedent that clearly demonstrate that the *Examiner* has the burden to prove that the specification is non-enabling. Instead of merely repeating the previous arguments, Applicants direct the Examiner's attention to *Chiron Corp. v. Genentech, Inc.*, 70 U.S.P.Q.2d 1321 (Fed. Cir. 2004), a copy of which is attached as Exhibit 1. In this recent Federal Circuit decision, the factors surrounding the enablement requirement are discussed in great detail. Applicants specifically direct the Examiner's attention to the fact that "a patent disclosure need not enable information within the knowledge of an ordinarily skilled artisan." *Id.* at 1325. Indeed, the Federal Circuit stated that "a patentee preferably omits from the disclosure any routine technology that is well known at the time of application." *Id.* This binding precedent of the Federal Circuit is particularly applicable to present claims 6, 12, 19, and 144, since the claimed "quality factor" is notoriously well known in the art of circuit design and has been for many years. One example of an explanation of such a quality factor is attached as Exhibit 2, although Applicants are confident that the Examiner can locate many other similar examples that relate to the calculation of quality factors. Since the manner in which a quality factor could be determined was well within the ordinary skill of the art at the time the present application was filed, Applicants respectfully submit that the specification adequately complies with the requirements of 35 U.S.C. § 112, first paragraph, in view of the interpretation of this statute as set forth by the Federal Circuit in the *Chiron* case. Therefore, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 6, 12, 19, and 44.

### **Rejections Under 35 U.S.C. § 102**

The Examiner rejected claims 1, 2, 4, 5, 8-11, 13, 16, 17, 22, and 23 under 35 U.S.C. § 102(b) as being anticipated by the Su reference. Specifically, the Examiner stated:

Su discloses a computer system, comprises: a chassis that encloses at least one microprocessor, the chassis having a rear wall which faces away from a user during normal use; and an

electro-acoustic transducer (i.e., speaker) mounted in the chassis, wherein the speaker is mounted to the rear wall designed for free-space operation (Fig. 3 show a computer which includes a plurality of computer speakers 10 mounted on the rear side of the computer). The chassis of the computer would inherently having an acoustic impedance magnitude of less than half that of an acoustic suspension box of the same dimension. The computer would have also inherently including a sound card and one of the speakers 10 can be viewed as an external speaker. As for claim 10, the computer base can be read as a main system module. The acoustic speaker output signals would inherently including wall-effect for providing acoustic spatial impression when the computer system is being used inside a room has walls.

Applicants respectfully traverse this rejection. Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Thus, if the claims contain even one recitation not found in the cited reference, the reference does not anticipate the claimed subject matter.

Applicants respectfully submit that the Examiner has misinterpreted the subject matter that the Su reference *actually* discloses and that the Examiner has not provided any support for the Examiner's assertions of what the Su reference *inherently* discloses. In regard to the first issue, the Examiner stated that Fig. 3 of the Su reference illustrates "a computer that includes a plurality of computer speakers 10 mounted on the rear side of the computer." Applicants respectfully disagree with the Examiner's interpretation of the Su reference. Fig. 3 merely illustrates a known docking base that includes a step-shaped frame 21 having "the sound outlets of the speaker unit 10...oriented rearwardly relative to the front portion 21A

upon which a portable computer 20 can be mounted.” Su, col. 1, lines 19-32. Hence, Fig. 3 does *not* disclose that the speakers are “mounted to said rear wall” as set forth in claim 1. Furthermore, the Su reference does not disclose that the docking base encloses “at least one microprocessor” as set forth in claim 1. Given these glaring deficiencies, it is clear that the Su reference does not anticipate the subject matter set forth in independent claim 1 nor in dependent claims 2, 4, 5, 8, or 9. Similarly, in regard to independent claim 10, the Su reference does not disclose that a driver is “mounted to said rear wall” of the chassis. Therefore, the Su reference cannot anticipate the subject matter of independent claim 10, nor the subject matter of dependent claims 11 and 13. Therefore, to the extent that the Examiner has asserted that the subject matter set forth in claims 1, 2, 4, 5, 8-11, and 13 is explicitly disclosed in the Su reference, Applicants respectfully submit that the Examiner is mistaken in this regard as these claims clearly include subject matter that is not explicitly disclosed in the Su reference. Accordingly, Applicants respectfully request withdrawal of the Examiner’s rejection of claims 1, 2, 4, 5, 8-11, and 13.

In regard to the second issue related to the Examiner’s allegations of inherency, Applicants respectfully remind the Examiner that if the Examiner relies on a theory of inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Examiner, in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden.

*See id.* Regarding functional limitations, the Examiner must evaluate and consider the functional limitation, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See* M.P.E.P. § 2173.05(g); *In re Swinehart*, 169 U.S.P.Q. 226, 229 (C.C.P.A. 1971); *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997). If the Examiner believes the functional limitation to be inherent in the cited reference, then the Examiner “must provide some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Inter. 1986).

In the present case, the Examiner has provided absolutely no evidence whatsoever to demonstrate that the subject matter that is explicitly missing from the Su reference is “necessarily” present. Indeed, the Examiner has merely made bald assertions, which are wholly unsupported by evidence of any kind, regarding items that the Examiner considers to be inherently disclosed by the Su reference. For example, the Examiner stated that the chassis of the computer would inherently have an acoustic impedance magnitude of less than half that of an acoustic suspension box of the same dimension, but the Examiner provided no evidence whatsoever to support this assertion. The Examiner further stated that the computer would also inherently include a sound card and that acoustic speaker output signals would inherently include wall-effect. Again, however, the Examiner provided no evidence whatsoever to support these assertions. Finally, in regard to claims 16, 17, 22, and 23, the Examiner asserted that the claimed methods would be inherent in the structure shown in the references. However, as stated above, the Su reference does not disclose that any processors are contained within the docking station 21 or that the speakers are actually mounted in a rear wall of the docking station 21-- it merely discloses that sound outlets of the speaker unit 10 are oriented rearwardly. Hence, the subject matter of independent claim 16, which sets forth

*inter alia* “executing application software in one or more programmable processors contained within a chassis, said chassis having a rear wall that faces away from a user during normal use, wherein said driver is mounted in said rear wall,” cannot be anticipated, either explicitly or inherently, by the disclosure of the Su reference. Likewise, dependent claims 17, 22, and 23 distinguish over the Su reference as well.

In view of the remarks set forth above, Applicants respectfully submit that the subject matter of claims 1, 2, 4, 5, 8-11, 13, 16, 17, 22, and 23 is not anticipated, either explicitly or inherently, by the disclosure of the Su reference. Accordingly, Applicants respectfully request withdrawal of the Examiner’s rejection and allowance of these claims.

### **Rejections Under 35 U.S.C. § 103**

The Examiner rejected claims 13, 14, 18, 24, 30-33, 35, 37, and 38 under 35 U.S.C. § 103(a) as being unpatentable over the Su reference in view of the Sugimura reference. Specifically, the Examiner stated:

Regarding claims 3, 14, 18, 24, 30-33, 35 and 37-38, what’s not taught by Su as discussed above in independent claims 1, 20 and 16 is the speaker is mounted to the center of the rear wall of the computer chassis that faces away from a user during normal use. It would have been to one of ordinary skill in the art to combine the teaching of Su and Sugimura by mounting speakers at the rear wall of the computer chassis that faces away from a user during normal use in order to create a better stereophonic or surround sound. Although Sugimura did not specifically show the speaker being arranged at center of the rear wall, one or ordinary skilled in the art would have been realized mounting speaker at various place(s) according to one’s desired preference would have been obvious. And the output sound generation would have been inherently created in a range in front of the user’s face when using the computer system.

Regarding claims 30-33 and 35, both computer systems of Su and Sugimura would have included a sound source such as a CD player, a wave table, or a speaker phone. And a sound card

is generally included in a computer system for audio signals processing.

Applicants respectfully traverse this rejection. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

As discussed above in regard to independent claims 1, 10, and 16, the Su reference does not disclose the subject matter set forth in these claims either explicitly or inherently. Because the Sugimura reference does not cure the deficiencies of the Su reference, dependent claims 3, 14, and 18 distinguish over the combination of the Su and Sugimura references for at least the reasons set forth above.

In regard to claims 3, 14, 18, 24, 37, and 38, the Examiner admitted that the Su reference does not disclose that a speaker is mounted to the center of a rear wall of a computer chassis that faces away from a user during normal use. The Examiner is apparently attempting to rely on the Sugimura reference to cure this deficiency. However, the Examiner admitted that the Sugimura reference does not specifically show that the speaker is arranged at the center of the rear wall. Instead, the Examiner merely asserted that it would have been obvious to one of ordinary skill in the art to mount the “speaker at various place(s) according to one’s desired

preference.” First, the Examiner’s assertion in this regard is wholly unsupported by evidence and, thus, inadequate to meet the Examiner’s burden of proof. Furthermore, even if the Examiner’s assertion is true, knowing that a speaker could be mounted at “various places” does not render mounting a speaker “in a rear wall” obvious. Finally, the Examiner does not even specifically mention how the combination of the Su and Sugimura references renders the subject matter set forth in claims 24, 37, and 38 obvious. Consequently, Applicants respectfully submit that the Examiner has not demonstrated that the subject matter set forth in claims 3, 14, 18, 24, 37, and 38 is obvious in view of the Su and Sugimura references.

In regard to claims 30-33 and 35, the Examiner stated that both computer systems of Su and Sugimura would have included a “sound source such as a CD, a wave table, or speaker phone” and that a “sound card is generally included a computer system.” However, neither the Su reference nor the Sugimura reference provide any disclosure whatsoever to support the Examiner’s allegations. Again, it appears to Applicants that the Examiner is improperly rejecting claims that clearly distinguish over the prior art of record instead of allowing such claims as the Examiner’s duty clearly requires.

In view of the remarks set forth above, Applicants respectfully submit that the subject matter of claims 3, 14, 18, 24, 30-33, 35, 37, and 38 is not rendered obvious by the teachings of the Su and Sugimura references. Accordingly, Applicant’s respectfully request withdrawal of the Examiner’s rejection and allowance of these claims.

The Examiner also rejected claims 20, 21, 25-29, 34, and 36 under 35 U.S.C. § 103(a) as being unpatentable over the Su reference in view of the Sugimura reference and further in view of the Koyama reference. However, the Koyama reference does not cure the deficiencies of the Su and Sugimura references discussed previously. Accordingly, these claims are

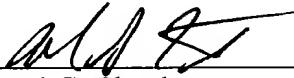
believed to be allowable for at least the reasons discussed previously. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of these claims.

**Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request withdrawal of the Examiner's rejections and allowance of claims 1-44. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: June 9, 2005

  
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Michael G. Fletcher  
Reg. No. 32,777  
(281) 970-4545

**Correspondence Address:**

**HEWLETT-PACKARD COMPANY**  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, Colorado 8527-2400